REMARKS

Claims 2-4 are all the claims pending in the application.

The Office Action Summary Page of the present Office Action lists claims 1-4 as the pending claims. However, Applicants respectfully draw the Examiner's attention to cancellation of claim 1 in the Amendment filed on March 19, 2001. Accordingly, Applicants assert that the pending claims are claims 2-4.

Claim 2 is amended herein to include the elements of dependent claim 4, and claim 4 is cancelled herein without prejudice or disclaimer. No new matter within the meaning of 37 C.F.R. § 1.121(f) is introduced. Entry of this amendment and cancellation of claim 4 is requested.

Rejection under 35 U.S.C. § 102(b)

Claims 2-4 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated over Groff (U.S. Patent No. 4,308,313).

Applicants assert that this rejection is rendered moot by the amendment to claim 2 herein. Groff teaches an improved backing for electrical insulating pressure-sensitive adhesive tape, in which the improved backing comprises a resin-bonded web which consists essentially of one or more layers of a non-woven backing comprising polymeric fibers and a cross-linked polymeric resin (col. 2, lines 4-9). With respect to the Examiner's specific citation of the teaching at col. 2, lines 60-67, Groff teaches the coating of an electrically-insulating resin composition onto one or both faces of the resin-bonded web. With respect to the Examiner's citation of Example 3, Groff

teaches coating a thermosetting resin onto both sides of the resin-bonded web and curing the coatings at 135 °C.

Applicants assert that the thermosetting resin of Groff is distinct from the thermoplastic polymer of claim 2 as amended herein. First, the thermosetting resin of Groff is a composition based on brominated epoxidized polyester and brominated epoxy resin (col. 6, lines 1-3). This composition is thermosetting and is thus cured by heating. In contrast, the thermoplastic polymer of claim 2, as amended, is disclosed at page 8, ¶ 2, as being preferably a film made of a polyolefin polymer such as polyethylene, polypropylene, or a mixture thereof, or a thermoplastic polyamide or polyester. Thus, the composition of the thermosetting resin of Groff is distinct from the thermoplastic polymer of claim 2.

Second, the physical properties of the thermosetting resin of Groff are distinct from the thermoplastic polymer of claim 2. Groff teaches the heat curing of the thermosetting resin (col. 6, line 3), while the present specification teaches that, because of the thermoplastic property of the film polymer, the film may, for example, be heat extruded onto the non-woven fabric (see bridging paragraph between pages 8 and 9).

Thus, Applicants assert that Groff does not teach or suggest all of the elements of claim 2 as amended, and therefore cannot anticipate claim 2 or dependent claim 3. Accordingly, Applicants request that the rejection be withdrawn.

Rejections under 35 U.S.C. § 103

(a) Claims 2-4 are rejected under 35 U.S.C. § 103(a) as being allegedly obvious over Wenzelberger et al. (U.S. Patent No. 2,352,463) in view of Brown et al. (U.S. Patent No. 5,662,978).

(b) Claims 2-4 are rejected under 35 U.S.C. § 103(a) as being allegedly obvious over Mamish (U.S. Patent No. 5,227,225) in view of Deeb et al. (U.S. Patent No. 6,042,882).

(c) Claims 2-4 are rejected under 35 U.S.C. § 103(a) as being allegedly obvious over Shirai et al. (U.S. Patent No. 6,037,054 or EP 839886 A2) in view of Brown et al. (U.S. Patent No. 5,662,978) and further in view of Deeb et al. (U.S. Patent No. 6,042,882).

Applicants respectfully traverse these rejections on the grounds that none of the three combinations cited renders claim 2 as amended herein, or claim 3, obvious. Claim 4 is cancelled.

With respect to rejection (a), Applicants assert that one of ordinary skill would not have had a motive to combine the teaching of Wenzelberger et al. with the film of Brown et al. Wenzelberger et al. teaches a rubber barrier sheet that is interposed between the adhesive and backing layers of the adhesive coated fabric for the purpose of preventing the adhesive from striking through the fabric (col. 2, lines 15-28). Certain rubber compositions are disclosed as particularly effective in this regard (see, col 4, ¶ 1). In contrast, no adhesive outer layer at all is taught by Brown et al., and no motivation to use a polymer film in place of the rubber film of Wenzelberger et al. is taught or suggested in either reference. Thus, one of ordinary skill would not have been motivated to combine the teachings of the film of Brown et al. with the adhesive coated fabric of Wenzelberger et al.

The thermoplastic polymer film of the present invention confers certain advantages that are disclosed in the present application. At page 8, ¶ 3, for example, it is disclosed that the polymer film contributes to the desirable properties of peeling workability and good adhesion with no wrinkle to curved surfaces. Neither cited reference teaches or suggests these properties or how they might be achieved. Applicants therefore assert that, in addition to a lack of motivation to combine, one of ordinary skill would not have had a reasonable expectation of success in combining the cited references to arrive at the present invention, because neither of these advantageous properties of the present invention is taught or suggested by the cited references.

In addition, Applicants respectfully reassert that Brown et al. and Wenzelberger et al. are not combinable because they are non-analogous art. Wenzelberger et al teaches laminated fabrics that are useful as protective covers for vehicles and equipment (see, col. 1, lines 17-19), while Brown et al. teaches improved adhesive tapes such as surgical dressings (see, col.1 ¶ 1). The Examiner's assertion that the references teach similar uses is respectfully disagreed with. Applicants assert that the different uses and the absence of adhesion in the teaching of Wenzelberger et al. clearly place the two teachings in non-analogous arts, which are therefore not properly combined.

For the foregoing reasons, Applicants request that rejection (a) be withdrawn.

With respect to rejection (b), Applicants reassert that one of ordinary skill would not have been motivated to modify the teaching of Mamish to position the polymer layer as taught by Deeb et al. In rejecting this argument in the present Office Action, the Examiner cites Deeb et al. at col. 7, lines 34-47 for the required motivation to combine. Applicants respectfully disagree that Deeb et al. provides such motivation. At the cited section, the benefits of the tape backing are

taught as preventing the adhesive from striking through to the side of the tape opposite to the adhesive. Applicants assert that these benefits provide no motivation to reposition the polymer layer of Mamish between the adhesive and non-woven fabric because the benefits attributed by Deeb et al. are already present in Mamish. Specifically, Mamish teaches a polymer layer on the opposite side of the fabric to the adhesive layer. Applicants assert that such a construction would already prevent the adhesive from striking through to the side of the tape opposite to the adhesive. Thus, Applicants assert that the cited section does not provide any motivation to combine the references and reposition the polymer layer with respect to the adhesive layer, and that no motivation exists in the cited references for such a combination.

Applicants respectfully request that rejection (b) be withdrawn.

With respect to rejection (c), the Examiner admits that neither Shirai et al. nor Brown et al. discloses the thermoplastic film as being located between the pressure-sensitive adhesive layer and the non-woven fabric (see, paper 13, ¶ 9). The Examiner relies upon Deeb et al. for this teaching. Applicants assert the lack of a motivation to combine the teaching of Deeb et al. with the teaching of Shirai et al. and Brown et al. for reasons given above in response to rejection (b). Thus, Applicants again assert that the rejection as stated requires significant reconstruction of the prior art, and appear to be a based on an "obvious to try" rationale and the impermissible use of hindsight with the benefit of the teachings in Applicants' specification.

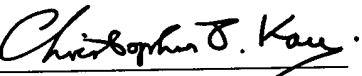
Applicants respectfully request that rejection (c) be withdrawn.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner

feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,



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Date: February 28, 2002

APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claim 4 is canceled.

The claims are amended as follows:

2. (thrice amended) A sheet for protecting paint films of automobiles, which comprises a support comprising a polymer film laminated on one or both surfaces of a non-woven fabric, and a pressure-sensitive adhesive layer formed on one surface of said polymer film opposed to the polymer film surface adhered to the non-woven fabric, wherein said non-woven fabric has a basis weight of 5 to 100 g/m^2 and said polymer film comprises a thermoplastic polymer.